

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed September 22, 2006. Upon entry of the amendments in this response, claims 1 – 6, 9 – 12, and 20 - 22 remain pending. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Rejections Under 35 U.S.C. §103**

The Office Action indicates that claims 1 – 4, 12 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Danzyger* in view of *Suzuki*. The Office Action also indicates that claims 5, 6, 9 – 11, 21 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Danzyger* in view of *Suzuki* and further in view of *Adams*. The Office Action further indicates that claims 1 – 4, 12 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Chang* in view of *Suzuki*. The Office Action further indicates that claims 5, 6, 9 – 11, 21 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Chang* in view of *Adams*. Applicants respectfully traverse these rejections.

### **Rejections of Claims 1 – 4, 12 and 20 over *Danzyger* and *Suzuki***

With respect to the rejection of claims 1 – 4, 12 and 20 over *Danzyger* in view of *Suzuki*, the Office Action indicates that *Danzyger* discloses all the limitations of these claims except for a particular location of the right click actuator around the track ball, thereby defining an aperture into which the track ball protrudes. However, the Office Action indicates that *Suzuki* discloses a related input device comprising a track ball and an actuator and that it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of *Suzuki* and *Danzyger*. The Office Action

admits that the combination of *Danzyger* and *Suzuki* does not expressly teach to locate the right click actuator or the left click actuator around the track ball.

In this regard, the Office Action refers to Applicants' specification and then concludes that (based on Applicants' disclosure) it would have been obvious to locate *Danzyger*'s right click actuator around the track ball, thereby defining an aperture into which the track ball protrudes, as desired, since such modification would involve a mere change in the location of the right click actuator. Moreover, the Office Action indicates that a change in location is generally recognized as being within the level of ordinary skill in the art, and refers to *In re Japikse*, 86 U.S.P.Q. 70 (CCCA 1950). Applicants respectfully assert that the aforementioned rejection is improper for several distinct reasons.

First, Applicants respectfully assert that *Suzuki* does not involve a related input device as alleged in the Office Action. In particular, *Suzuki* involves the use of a track ball and a surrounding switch that provides functionality involved with moving a cursor display to an operator. This is in contrast to actuating functionality associated with a cursor as is accomplished using a right click actuator. Therefore, regardless of how *Suzuki* is used in formulating the aforementioned rejection, it is only proper for that use to involve a switch for moving a cursor. Since such functionality is not recited in Applicants' pending claims, the inapplicability of *Suzuki* as an appropriate reference for rejecting the pending claims should be apparent. Therefore, Applicants respectfully request that the rejection be removed for at least this reason.

Second, the Office Action appears to be using impermissible hindsight in order to formulate the rejection. In particular, the Office Action specifically refers to Applicants' disclosure as follows:

***Since Applicants disclose that the aperture is not necessarily defined by the right click actuator and can be located adjacent to the right-click actuator (see page 4, lines 14 – 16). Therefore, it would have been obvious***

to a person of ordinary skill in the art at the time the invention was made to locate the *Danzyger* right-click actuator around the track ball, thereby defining an aperture into which the track ball protrudes, as desired, since such modification would have involved a mere change in the location of the right-click actuator.

(Office Action, page 3, lines 15 – 20). (Emphasis added).

In this regard, the Office Action is referring to Applicants' inventive teachings and then summarily concludes that those teachings justify altering teachings of the prior art in a manner that allegedly renders the pending claims unpatentable. Clearly, such is not a recognized standard of examination and Applicants respectfully request that the rejections be withdrawn for at least this reason. Moreover, Applicants' claim 1 recites "wherein the right-click actuator defines an aperture and the trackball protrudes into the aperture." Since it is the language of the claims that is being examined, the statement in the Office Action indicating that Applicants disclose that the aperture is not necessarily defined by the right click actuator appears to be misplaced and irrelevant to examination of the claims.

Third, the Office Action appears to indicate that a change in location is generally recognized as being within the level of ordinary skill in the art as indicated by *In re Japikse*. Although Applicants can envision situations in which the change of location of various components could be considered within the level of ordinary skill, such certainly would not be the case when the locations themselves relate to structural and functional aspects that provide a synergistic effect and are germane to the invention. Additionally, the *In re Japikse* case is in no manner related to the proposition for which the Office Action indicates its applicability in the rejection of the pending claims. In this regard, *In re Japikse* involves upholding an Examiner's rejection of an application despite an Applicant's contention that a cited reference is inoperable based on the drawings of the cited reference. In particular, that case indicates that it is within the level of ordinary skill in the art to make modifications to a reference such that the reference is not deemed inoperable. *In re Japikse* does not, however,

stand for the proposition that a change in location is generally recognized as being within the level of ordinary skill in the art. Therefore, for at least this reason, Applicants respectfully assert that the rejection is improper and should be removed.

Based on the foregoing, Applicants respectfully assert that the rejections of claim 1 over *Danzyger* in view of *Suzuki* is improper. Applicants respectfully request therefore, that the rejection be removed and that this claim be placed in condition for allowance. Since claims 4, 12 and 20 are dependent claims that incorporate the limitations of claim 1, Applicants respectfully assert that these claims are in condition for allowance. Additionally, these dependent claims recite other features that can serve as an independent basis for patentability.

**Rejections of claims 5, 6, 9 – 11, 21 and 22 over *Danzyger*, *Suzuki* and *Adams***

With respect to claims 5, 6, 9 – 11, 21 and 22, Applicants respectfully assert that the rejections of these claims under *Danzyger* in view of *Suzuki* and further in view of *Adams* are improper for various independent reasons. In this regard, *Adams* discloses the use of left and right click actuators that are aligned with a thumb of a user. In general, the Office Action indicates that these components of *Adams* could be relocated in order provide more ergonomic and comfortable use. However, it appears that the Office Action has disregarded various other teachings of *Adams* that make such relocation impermissible.

In particular, column 6, lines 40 – 48 of *Adams* indicates that a recess 101 surrounds track ball 32. Particular functionality and characteristics are attributed to this recess, thereby teaching away and/or otherwise rendering it impermissible to relocate a right click actuator about such a track ball as is generally recited in Applicants' pending claims. Therefore, for at least this independent reason, Applicants respectfully assert that the rejections of these claims are improper and that these claims are in condition for allowance.

Second, the deficiencies of *Danzyger* and *Suzuki* are described above with respect to the rejection of claim 1. Since the aforementioned deficiencies of *Danzyger* and *Suzuki* are not remedied by *Adams*, Applicants respectfully assert that claims 5, 6, 9 – 11, 21 and 22 are in condition for allowance as dependent claims that incorporate the limitations of claim 1. Additionally, these dependent claims recite other features that can serve as an independent basis for patentability.

Based on the foregoing, Applicants respectfully assert that the rejections of claims 5, 6, 9 – 11, 21 and 22 over *Danzyger* in view of *Suzuki* and further in view of *Adams* are improper and that these claims are in condition for allowance.

#### **Rejections of Claims 1 – 4, 12 and 20 over *Chang* and *Suzuki***

With respect to the rejection of claims 1 – 4, 12 and 20 under *Chang* and *Suzuki*, the Office Action indicates that *Chang* discloses all the limitations of these claims except for a particular location of the right click actuator around the track ball, thereby defining an aperture into which the track ball protrudes. However, the Office Action indicates that *Suzuki* discloses a related input device comprising a track ball and an actuator and that it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of *Chang* and *Suzuki*. The Office Action admits that the combination of *Chang* and *Suzuki* does not expressly teach to locate the right click actuator or the left click actuator around the track ball.

In this regard, the Office Action once again refers to Applicants' specification and then concludes that (based on Applicants' disclosure) it would have been obvious to locate *Danzyger's* right click actuator around the track ball, thereby defining an aperture into which the track ball protrudes, as desired, since such modification would involve a mere change in the location of the right click actuator. Moreover, the Office Action indicates that a change in

location is generally recognized as being within the level of ordinary skill in the art, and refers to *In re Japikse*, 86 U.S.P.Q. 70 (CCCA 1950). Applicants respectfully assert that the aforementioned rejection is improper for several distinct reasons.

First, Applicants respectfully assert that *Suzuki* does not involve a related input device as alleged in the Office Action. In particular, *Suzuki* involves the use of a track ball and a surrounding switch that provides functionality involved with moving a cursor display to an operator. This is in contrast to actuating functionality associated with a cursor as is accomplished using a right click actuator. Therefore, regardless of how *Suzuki* is used in formulating the aforementioned rejection, it is only proper for that use to involve a switch for moving a cursor. Since such functionality is not recited in Applicants' pending claims, the inapplicability of *Suzuki* as an appropriate reference for rejecting the pending claims should be apparent. Therefore, Applicants respectfully request that the rejection be removed for at least this reason.

Second, the Office Action appears to be using impermissible hindsight in order to formulate the rejection. In particular, the Office Action specifically refers to Applicants' disclosure as follows:

*Since Applicants disclose that the aperture is not necessarily defined by the right click actuator and can be located adjacent to the right-click actuator (see page 4, lines 14 – 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to locate the Chang right-click actuator around the track ball, thereby defining an aperture into which the track ball protrudes, as desired, since such modification would have involved a mere change in the location of the right-click actuator.*

(Office Action, page 6, line 21 to page 7, line 5). (Emphasis added).

In this regard, the Office Action is referring to Applicants' inventive teachings and then summarily concludes that those teachings justify altering teachings of the prior art in a manner that allegedly renders the pending claims unpatentable. Clearly, such is not a recognized standard of examination and Applicants respectfully request that the rejections be

withdrawn for at least this reason. Moreover, Applicants' claim 1 recites "wherein the right-click actuator defines an aperture and the trackball protrudes into the aperture." Since it is the language of the claims that is being examined, the statement in the Office Action indicating that Applicants disclose that the aperture is not necessarily defined by the right click actuator appears to be misplaced and irrelevant to examination of the claims.

Third, the Office Action appears to indicate that a change in location is generally recognized as being within the level of ordinary skill in the art as indicated by *In re Japikse*. Although Applicants can envision situations in which the change of location of various components could be considered within the level of ordinary skill, such certainly would not be the case when the locations themselves relate to structural and functional aspects that provide a synergistic effect and are germane to the invention. Additionally, the *In re Japikse* case is in no manner related to the proposition for which the Office Action indicates its applicability in the rejection of the pending claims. In this regard, *In re Japikse* involves upholding an Examiner's rejection of an application despite an Applicant's contention that a cited reference is inoperable based on the drawings of the cited reference. In particular, that case indicates that it is within the level of ordinary skill in the art to make modifications to a reference such that the reference is not deemed inoperable. *In re Japikse* does not, however, stand for the proposition that a change in location is generally recognized as being within the level of ordinary skill in the art. Therefore, for at least this reason, Applicants respectfully assert that the rejection is improper and should be removed.

Based on the foregoing, Applicants respectfully assert that the rejections of claim 1 over *Chang* in view of *Suzuki* is improper. Applicants respectfully request therefore, that the rejection be removed and that this claim be placed in condition for allowance. Since claims 4, 12 and 20 are dependent claims that incorporate the limitations of claim 1, Applicants

respectfully assert that these claims are in condition for allowance. Additionally, these dependent claims recite other features that can serve as an independent basis for patentability.

**Rejections of claims 5, 6, 9 – 11, 21 and 22 over *Chang* and *Adams***

With respect to claims 5, 6, 9 – 11, 21 and 22, Applicants respectfully assert that the rejections of these claims under *Chang* in view of *Adams* are improper for various independent reasons. In this regard, *Adams* discloses the use of left and right click actuators that are aligned with a thumb of a user. In general, the Office Action indicates that these components of *Adams* could be relocated in order provide more ergonomic and comfortable use. However, it appears that the Office Action has disregarded various other teachings of *Adams* that make such relocation impermissible.

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Second, the deficiencies of *Chang* are described above with respect to the rejection of claim 1. Since the aforementioned deficiencies of *Chang* are not remedied by *Adams*, Applicants respectfully assert that claims 5, 6, 9 – 11, 21 and 22 are in condition for allowance as dependent claims that incorporate the limitations of claim 1. Additionally, these dependent claims recite other features that can serve as an independent basis for patentability.

Based on the foregoing, Applicants respectfully assert that the rejections of claims 5, 6, 9 – 11, 21 and 22 over *Danzyger* in view of *Suzuki* and further in view of *Adams* are improper and that these claims are in condition for allowance.



### **Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

### **CONCLUSION**

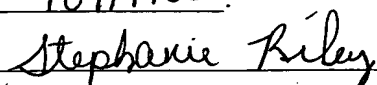
In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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